

Appln. No. 10/076,563
Amendment dated October 8, 2004
Reply to Office Action mailed July 9, 2004

REMARKS

Reconsideration is respectfully requested.

Claims 1 through 12 remain in this application. Claims 13 through 20 have been added.

The Examiner's rejections will be considered in the order of their occurrence in the Office Action.

Paragraph 1 of the Office Action

Claims 1-9 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Yagi (US 6,725,020) in view of Garfinkel (US 6,157,298) and further in view of Truesdale (US 6,115,846).

The law regarding obviousness is clear--any modification of the prior art must be suggested or motivated by the prior art:

'Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so.' [citation omitted] Although couched in terms of combined teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious "modification" of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.

In re Fritch, 972 F.2d 1260; 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992), (in part quoting from ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577; 221 USPQ 929, 933 (Fed. Cir. 1984)).

It is submitted that the combination of Yagi with Garfinkel and Truesdale is not suggested by the prior art, and even if such a combination were to be made, one would not be led to the combination of features recited in applicants' claims. In particular, the references do not disclose, teach or suggest "a playing assembly being positioned in said perimeter wall of said helmet, said playing assembly being adapted for reading audio information

Appln. No. 10/076,563

Amendment dated October 8, 2004

Reply to Office Action mailed July 9, 2004

from a compact disc" and "each of a plurality of speakers being positioned in said perimeter wall of said helmet, each of said speakers being operationally coupled to said playing assembly, each of said speakers being adapted for audibly playing the audio information read by said playing assembly". The Yagi reference teaches a helmet with incorporated communication system that fails to teach a playing assembly being positioned in the perimeter wall of the helmet to read information from a compact disc with speakers positioned in the perimeter wall of the helmet to audibly playing the audio information read by the playing assembly as claimed by the applicant. The Garfinkel reference teaches a safety helmet that fails to teach a playing assembly being positioned in the perimeter wall of the helmet to read information from a compact disc with speakers positioned in the perimeter wall of the helmet to audibly playing the audio information read by the playing assembly as claimed by the applicant. The Office Action states:

"Garfinkel teaches a playing assembly being positioned in the perimeter wall of the helmet (see fig. 1, col. 2, lines 5-31, col. 4, line 54- col. 5, line 28), inherently teaches a speaker positioned in the perimeter wall of the helmet,..."

The Garfinkel reference is completely silent on the use of a playing assembly to read the audio information from a compact disc. Additionally, the Garfinkel teaches away from that claimed by the applicant in that the Garfinkel reference, as can be seen from Figures 1 through 3 of the reference, teaches the earphone assembly being positioned below the helmet and positioned slightly away from the helmet. The Truesdale reference teaches headgear combined with a fan, electronic communication device and binoculars that fails to teach a playing assembly being positioned in the perimeter wall of the helmet to read information from a compact disc with speakers positioned in the perimeter wall of the helmet to audibly playing the audio information read by the playing assembly as claimed by the applicant. Further, the Truesdale reference teaches away from that claimed

Appln. No. 10/076,563
Amendment dated October 8, 2004
Reply to Office Action mailed July 9, 2004

by the applicant in that the Truesdale reference teaches the earphones attached to the head gear to allow adjustability of the of the earphones with respect to the headgear and to allow the earphones to positioned away from the ears as the earphones are suspended from the head gear as shown in Figures 1 through 5 and col. 3, lines 18 through 29. It is also submitted that the mere fact that one may argue that the prior art is capable of being modified to achieve a claimed structure does not by itself make the claimed structure obvious--there must be a motivation provided by the prior art, and that motivation is totally lacking in the reference.

The examiner finds the claimed shape would have been obvious urging that (our emphasis) "it is obvious for one skilled in the art to form each hook base of any desired shape *** since *this is within the capabilities of such a person.*" Thus, the examiner equates that which is within the capabilities of one skilled in the art with obviousness. Such is not the law. There is nothing in the statutes or the case law which makes "that which is within the capabilities of one skilled in the art" synonymous with obviousness.

The examiner provides no reason why, absent the instant disclosure, one of ordinary skill in the art would be motivated to change the shape of the coil hooks of Hancock or the German patent and we can conceive of no reason.

Ex parte Gerlach and Woerner, 212 USPQ 471 (PTO Bd. App. 1980)
(emphasis in original).

Therefore, it is submitted that the combination of the Yagi reference with the Garfinkel and Truesdale references would not lead one to the combination of features as claimed by the applicant.

Withdrawal of the §103(a) rejection of claims 1-9 is therefore respectfully requested.

Paragraph 2 of the Office Action

Paragraph 2 of the Office Action states that claims 10 and 11 would be allowable if written into independent form with the limitations of the base claim and any intervening claims.

Appln. No. 10/076,563
Amendment dated October 8, 2004
Reply to Office Action mailed July 9, 2004

New claims 13 through 20 have been added to vary the scope of the claims and clarify the present invention. All limitations are supported by the original disclosure including the specification, drawings and original claims. Claim 13 incorporates the limitations from claim 1 and allowable claim 10. Claims 14 through 20 incorporate the limitations of claims 3 through 9 respectively and are dependent on claim 13. Therefore, no new matter has been added. The new claims are believed to be allowable.

Paragraph 3 of the Office Action


Claim 12 is allowed.

CONCLUSION

In light of the foregoing amendments and remarks, early reconsideration and allowance of this application are most courteously solicited.

Respectfully submitted,

LEONARD & PROEHL, Prof. L.L.C.

By  Date: 10/12/04
Robert K. Huck (Reg. No. 45,761)
LEONARD & PROEHL, Prof. L.L.C.
3500 South First Avenue Circle, Suite 250
Sioux Falls, SD 57105-5807
(605)339-2028 FAX (605)336-1931